



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/915,678	08/21/97	BORST	C P-3875CON

MEDTRONIC INC
7000 CENTRAL AVENUE NE
MINNEAPOLIS MN 55432

QM41/0511

EXAMINER	
NASSER, R	
ART UNIT	PAPER NUMBER
3736	

DATE MAILED:

05/11/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/915,678

Applicant(s)
Borst et al

Examiner
Robert L. Nasser Jr.

Group Art Unit
3736



☒ Responsive to communication(s) filed on Aug 21, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 20-32 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3736

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d. 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d. 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d. 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.@d. 528, 163 USPQ 644 (CCPA 1969);, In re Vogel, 422 F.2d. 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d. 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.@d. 887, 225 USPQ 645 (Fed Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed Cir 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(b) would overcome an actual or provisional rejection on non-statutory double patenting grounds, provided that the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78(d).

Claims 20-32 are provisionally rejected under the judicially created doctrine of double patenting.

The subject matter recited in claims 20-32 of the present application was fully disclosed in application 08/531363. The allowance of the above listed claims would extend the rights to exclude already granted in the patent - that right to exclude covering the invention "comprising ABCX". The transitional phrase comprising does not exclude the presence of elements other than A, B, C, X in the claim. Because of the phrase "comprising" the patent not only provides

Art Unit: 3736

protection ABCX, but also extends patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claim(s) of the present application, because of the phrase "comprising" not only would provide patent protection to the claimed combination ABCY, but also would extend patent coverage to the combination ABCXY, already disclosed and covered by the patent. Thus, the controlling fact is that patent protection for the invention, fully disclosed in and covered by US Patent Application 08/531363 would be extended by allowance of these claims in the present application.

Furthermore, there is no reason why applicant could not have prosecuted the present claims during prosecution of the application 08/531363.

This is a provisional rejection in that the claims have not in fact been patented.

For a more detailed discussion of this double patenting rejection, see MPEP 804(2), under the heading "Non-obvious type."

Claims 20-24 and 26-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20 and 26 are rejected in that they are drawn to a method of cardiac surgery, but do not include the steps of performing the surgery. Applicant should either recite a method for immobilizing the tissue during cardiac surgery or add the step of performing a surgical procedure after immobilization. Claim 30 is rejected in that in line 5, the word area is spelled are. Claims 21-24, 27-29, and 31-32 are rejected as being dependent on a rejected base claim. Clarification is required.

Art Unit: 3736

Claims 20-24 and 26-32 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 and the double patenting rejection set forth in this Office action, as none of the prior art shows a method of heart surgery where the heart tissue is immobilized using a suction apparatus. As admitted by applicant, some of the art immobilizes the heart using sutures, but none immobilizes the heart using suction.

Claim 25 would be allowable if the double patenting rejection were overcome, as none of the art shows a method of immobilizing tissue using two probes connected to the tissue with suction, and then pulled apart, to immobilize an area of tissue.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Garrison shows a similar method of heart surgery to applicant's.

Kazama shows an alternate heart retractor.

Benetti et al shows a very similar invention to applicant's. Presently, the claims are patentably distinct in that the Benetti claims recite an annular probe with plural suction ports and the present claims only recite one suction port. In addition, applicant's claims recite the step of fixing the first member to a stationary object, which is disclosed, but not claimed in Benetti et al. Therefore, at present, there are no interfering claims.

Art Unit: 3736

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser Jr. whose telephone number is (703) 308-3251. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Bahr, can be reached on (703) 308-1066. The fax phone number for this Group is (703) 308-0758.

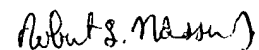
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [jennifer.bahr@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

RLN

May 5, 1998



**ROBERT L. NASSER
PRIMARY EXAMINER**